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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,650	04/19/2000	Paul Bucknell	PHB 34,339	2839

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PHILIPS ELECTRONICS NORTH AMERICAN CORP  
580 WHITE PLAINS RD  
TARRYTOWN, NY 10591

EXAMINER .

YUN, EUGENE

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 06/09/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/552,650

Applicant(s)

BUCKNELL ET AL.

Examiner

Eugene Yun

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4,6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/8/2003 has been entered.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 10-14 rejected under 35 U.S.C. 102(b) as being anticipated by British Telecommunications (BT) (EP 0825791).

Referring to Claim 10, BT teaches a method of configuring a profile of a fixed terminal comprising:

transmitting capabilities of said fixed terminal to a mobile terminal (see col. 5, lines 18-20);

selecting by said mobile terminal parameters that match said capabilities and transmitting said parameters to said fixed terminal (see col. 5, lines 35-45);

selecting by said fixed terminal a portion of said parameters to form selected parameters and informing said second terminal of said selected parameters (see col. 5, lines 46-49); and

transmitting by said mobile terminal to said fixed terminal required information to form said profile based on said selected parameters (see col. 5, lines 53-58).

Referring to Claim 11, BT also teaches requesting said capabilities of said fixed terminal by said mobile terminal (see col. 5, lines 6-8).

Referring to Claim 12, BT also teaches testing delivery integrity of said required information (see col. 6, lines 49-53).

Referring to Claim 13, BT also teaches testing delivery integrity of said required information (see col. 6, lines 49-53); and

requesting retransmission of said required information if said testing indicates an error in said delivery integrity (see col. 5, lines 53-58 and col. 7, lines 12-19).

Referring to Claim 14, BT also teaches acknowledging proper reception of said required information (see col. 6, lines 4-7).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Nodoushani (US 6,144,849).

Referring to Claim 9, Nodoushani teaches a fixed terminal for use in a communication system in which a mobile terminal can configure said fixed terminal by service negotiation, the fixed terminal comprising a transceiver 24 (fig. 2), a memory for storing software functions 34 (fig. 2), and a processor for controlling operation of the fixed terminal in accordance with stored software functions 32 (fig. 2), at least one of the software functions being alterable in response to the receipt of a message from said mobile terminal containing new software function plus interface software required by the processor in building the new function into an actual implementation on the fixed terminal (see col. 7, lines 32-47).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over BT and Nodoushani et al. (US 6,144,849) in view of Niska et al. (US 6,041,228).

Referring to Claim 2, BT teaches a method of operating a radio system comprising a mobile terminal and a fixed terminal. BT does not teach the method comprising said mobile terminal transmitting a message giving parameters relating to its capabilities. Nodoushani teaches the method comprising said mobile terminal transmitting a message giving parameters relating to its capabilities (see col. 6, lines 53-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Nodoushani to said method of BT in order to consume less power in a mobile telephone while programming a radio system. The combination of BT and Nodoushani does not teach said fixed terminal receiving the message and configuring itself in accordance with the received parameters. Niska teaches said fixed terminal receiving the message and configuring itself in accordance with the received parameters (see col. 3, lines 42-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Niska to said method of BT in order to avoid additional costs when operating a radio system.

Referring to Claim 6, BT teaches a communication system comprising a mobile terminal and a fixed which are able to communicate with each other. BT does not teach a message transmitted by said mobile terminal giving parameters relating to its capabilities. Nodoushani teaches a message transmitted by said mobile terminal giving

parameters relating to its capabilities (see col. 6, lines 53-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Nodoushani to said method of BT in order to consume less power in a mobile telephone while programming a radio system.

The combination of BT and Nodoushani does not teach said fixed terminal receiving the message and configuring itself in accordance with the received parameters. Niska teaches said fixed terminal receiving the message and configuring itself in accordance with the received parameters (see col. 3, lines 42-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Niska to said method of BT in order to avoid additional costs when operating a radio system.

Referring to Claim 3, Nodoushani also teaches the mobile terminal transmitting the required function plus software required in building a new function into an actual implementation on the fixed terminal (see col. 7, lines 32-47).

Referring to Claim 4, BT also teaches testing the air interface to ensure that configuration/reconfiguration has taken place without error (see col. 6, lines 49-53).

Referring to Claim 8, BT also teaches said fixed and mobile terminals each having a software interface (see col. 2, lines 7-21) including a memory and means for altering the memory (see col. 2, lines 27-29), and wherein at least a portion of the area of the memory has a part allocated to respective software functions, the memory altering means replacing the area of a respective part in response to a new function being downloaded (see col. 5, lines 53-58).

altering means replacing the area of a respective part in response to a new function being downloaded (see col. 5, lines 53-58).

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over BT in view of Morris et al. (US 6,112,206).

Referring to Claim 15, BT teaches a communication terminal comprising:

means for transmitting capabilities of said communication terminal to another terminal (see col. 5, lines 18-20);

means for receiving parameters from said another terminal, said parameters matching said capabilities (see col. 5, lines 35-45);

means for selecting a portion of said parameters to form selected parameters and informing said another terminal of said selected parameters (see col. 5, lines 49-58);

means for receiving from said another terminal required information to form a profile of said communication terminal based on said selected parameters (see col. 6, lines 1-4); and

means for configuring said profile in response to said required information from said another terminal (see col. 6, lines 4-7).

BT does not teach said another terminal as a server. Morris teaches said another terminal as a server (see ABSTRACT noting that a server can exist on a mobile unit).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the



invention was made to provide the teachings of Morris to said method of BT in order to reduce error when operating a radio system.

Referring to Claim 16, BT teaches a communication terminal comprising:  
a memory which stores data indicative of capabilities of said communication terminal (see col. 2, lines 27-29);

a transmitter which transmits said capabilities to another terminal (see col. 5, lines 18-20);

a receiver which receives parameters from said another terminal, said parameters matching said capabilities (see col. 5, lines 35-45);

a controller which selects a portion of said parameters to form selected parameters and informs said another terminal of said selected parameters (see col. 5, lines 49-58);

said receiver receiving from said another terminal required information to form a profile of said communication terminal based on said selected parameters (see col. 6, lines 1-4); and

said controller configuring said profile in response to said required information from said another terminal (see col. 6, lines 4-7).

BT does not teach said another terminal as a server. Morris teaches said another terminal as a server (see ABSTRACT noting that a server can exist on a mobile unit).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Morris to said method of BT in order to reduce error when operating a radio system.

***Response to Arguments***

9. Applicant's arguments with respect to claims 2-4, 6, and 8-16 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Eugene Yun  
Examiner  
Art Unit 2682

EY  
June 2, 2003



VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

6/2/03